

Appl. No. 09/773,334
Amd dated October 8, 2004
Reply to Office Action of July 8, 2004

REMARKS

This amendment is responsive to the Office Action dated July 8, 2004. Applicant has not amended or added any claims. Claims 1-3, 6, 7, 9-11 and 14-23 are pending.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 11, 16, 18, 20 and 23 under 35 U.S.C. § 102(b) as being anticipated by Walker et al. (U.S. Pat. No. RE38,189). Applicant respectfully traverses the rejections. Walker et al. fail to disclose each and every feature of the claimed invention, as required by 35 U.S.C. § 102(b), and provide no teaching that would have suggested the desirability of modification to include such features.

For example, Walker et al. fails to teach or suggest a housing being sized to receive an animal and a drip bag support coupled to the housing, as recited by Applicant's claims 1, 11, 16, 18, 20 and 23. According to the Examiner, the housing is seen inherently because the device is to be used in a hospital room, which the Examiner equates with a "housing." In order to sustain the inherency analysis, the prior art must necessarily function in accordance with, or include, the claimed limitation. MEHL/Biophile Int'l Corp. v. Milgraum, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), quoted in In re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002).

Nothing in Walker et al. specifies that the described administration monitoring system must necessarily operate in a room of any kind. Nor is there any indication in Walker et al. that the system must necessarily be coupled to the room. On the contrary, Walker et al. specifically discloses that the system is transportable from site to site, and therefore is not coupled to any room. Col. 2, lines 40-42; col. 3, lines 47-49; col. 4, lines 37-38; col. 7, lines 11-13; col. 9, lines 42-43. Walker et al. specifically declares that "delivering drugs to a patient site" and securing components for "transport and storage" are "fundamental" objects of the Walker apparatus. Col. 3, lines 37-39, 47-49.

In addition, the Examiner applies a meaning of "coupled" that is inconsistent with the ordinary meaning of the term. According to the Examiner, the fact that the Walker apparatus is on a floor means that the apparatus is "coupled to" the floor. This is an incorrect application of a

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term, as "coupled to" is not synonymous with "in contact with." In addition, the Examiner's interpretation of the term "coupled" leads to an absurd result, as it means that every tangible object on Earth is "coupled to" every other tangible object by the force of the planet's gravity.

Furthermore, claim 11 recites "a housing sized to receive an animal and to confine the animal during therapeutic treatment." The Examiner appears to have overlooked this element entirely. Nothing in Walker et al. suggests or necessarily requires any room sized "to confine" any animal.

Moreover, claims 20 and 23 recite "a support apparatus coupled to the housing, the support apparatus configured to stabilize the housing when a drip bag is supported by the drip bag support." Once again, the Examiner improperly relies upon inherency, rather than any disclosure in Walker et al. In any event, the Examiner's basis for rejection is without any merit. According to claims 20 and 23, the support apparatus stabilizes the housing, not another element. Assuming for the sake of argument that a hospital room is a "housing," there is nothing in Walker et al. that suggests or necessarily requires that the weight of the Walker apparatus stabilizes the hospital room when a drip bag is supported by a drip bag support. The Examiner's analysis is patently absurd.

Walker et al. fail to disclose each and every limitation set forth in claims 1, 11, 16, 18, 20 and 23. Furthermore, the Examiner cannot cure the deficiencies by inherency, because such would be contrary to the legal tests for inherency set forth by the Federal Circuit Court of Appeals..

For at least these reasons, the Examiner has failed to establish a *prima facie* case for anticipation of Applicant's claims 1, 11, 16, 18, 20 and 23 under 35 U.S.C. § 102(b). Withdrawal of this rejection is requested.

Claim Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim(s) 1 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Donawick et al. (U.S. Pat. No. 5,163,923) in view of Walker et al. Applicant respectfully traverses the rejections.

According to the Examiner, Donawick et al. discloses the elements of claims 1 and 11 except for the syringe cradle. The Examiner asserted, however, that because Walker et al.

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disclose a syringe cradle, it would be obvious to combine a Walker syringe cradle with a Donawick device.

In a proper obviousness determination, the prior art must give a reason or motivation for making the claimed invention. In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In re Lee emphasizes that evidence of motivation to combine references is not a trivial requirement, but is rather the best defense against a hindsight-based analysis. Id. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), underscores that combining prior art references without evidence of a suggestion, teaching or motivation to combine references simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, and this is the "essence of hindsight." A rigorous application of the requirement for a showing of the teaching or motivation to combine is "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis." Id.

Furthermore, In re Lee and In re Dembiczak further emphasize the importance of creation of an evidentiary record that supports a conclusion of obviousness. In re Lee, 61 USPQ2d at 1433-34; In re Dembiczak, 50 USPQ2d at 1617. The findings must be based upon evidence in the record, not upon the subjective belief of the Examiner. See In re Lee, 61 USPQ2d at 1434 (the factual inquiry into whether to combine references "must be based on objective evidence in the record"); In re Dembiczak, 50 USPQ2d at 1617 ("The range of sources available, however, does not diminish the requirement for actual evidence.").

The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. No evidence in the record supports any motivation to combine, and the Examiner does not cite any.

Moreover, the Examiner once again improperly relies upon inherency to make up for deficiencies in the cited references. Claims 1 and 11 recite "a drip bag support coupled to the housing," and the Examiner admits that Donawick et al. does not show any drip bag support coupled to any housing. The Examiner asserted, however, that the drip bag support had to be coupled to something. The Examiner's analysis is clearly legally incorrect. In order for inherency to come into play, the drip bag support must necessarily be coupled to a housing, and there is nothing in the record to support any such necessity.

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The Examiner further rejected claims 2, 3, 6, 7, 10 and 14-23 as being unpatentable over Donawick et al. in view of Walker et al. and further in view of Thrun (U.S. Pat. No. 6,349,675). Applicant respectfully traverses the rejections.

Once again, the Examiner has not proffered evidence of motivation to combine. Nothing in the cited references suggests any motivation to combine features of the references.

Applicant has previously argued that Thrun is not directed to a cover for an enclosure or housing used to confine an animal during therapeutic treatment, as recited in claims 7, 9, 10 and 22. Rather, Thrun is directed to a cover for an enclosure to hold a pet such as a ferret, hamster, gerbil, snake, chameleon, insect or arachnid. Thrun col. 1, lines 18-24. One interested in an animal confinement apparatus that confines the animal during therapeutic treatment and that balances animal confinement with simultaneous access to the animal by the caregiver would not look to Thrun for a cover for a housing. Applicant incorporates her arguments about the applicability of Thrun herein, without reciting them again at length.

Applicant has also previously argued that Thrun fails to disclose elements of the invention as recited in claims 2, 3, 6, 7, 10 and 14-23. For example, Thrun fails to disclose a first top panel hingedly coupled to the housing and a second top panel hingedly coupled to the housing, the first and second top panels being selectively positionable to cover at least a portion of the top opening, wherein the top opening is at least in part uncovered when the first and second top panels are in a closed position. Applicant incorporates her arguments about the disclosure of Thrun herein, without reciting them again at length.

Applicant wishes to point out, however, that the Examiner has apparently overlooked the language of claim 7. Claim 7 recites "wherein the top opening is at least in part uncovered when the first and second top panels are in a closed position." The Examiner improperly focuses upon the coverage of individual doors, and ignores whether a top opening is at least in part uncovered when the doors are closed. The Examiner directed Applicant to FIG. 5 of Thrun, but FIG. 5 does not show a top opening that is at least in part uncovered, as recited in claim 7.

The Examiner also asserted that because Thrun shows a screen material, at least part of the top opening is uncovered. This is an absurd reading of Thrun, as it means that the Thrun cover is not a cover. The Examiner compounds the absurdity in regard to claim 22, by asserting

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that the screen openings are "sized to permit a handler to touch the animal," as recited in claim 22. This assertion is preposterous on its face.

Claim 21 recites "wherein the support apparatus includes at least one extendable brace." The Examiner concedes that this element is not disclosed or suggested by any of the cited references, but that it is obvious because braces are "old and well known." As a matter of law, the Examiner applied the wrong standard.

Applicant also incorporates by reference arguments made above pertaining to Donawick et al. and Walker et al. In addition, the Examiner erred by asserting that Donawick et al. disclose a window and a grate, as recited in claim 6. Donawick et al. disclose no such thing. Donawick et al. disclose no such thing. Donawick et al. say not one word about a window or any grate covering any window. The Examiner's rejection of claim 6 is utterly unsupported by the evidence.

Applicant does not waive any of its arguments made previously, but for brevity incorporates them by reference herein.

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CONCLUSION

The Examiner asserted Donawick et al. and Walker et al. for the very first time in a final office action. For the reasons given above, these references do not support rejection of the claims.

Applicant will request an interview with the Examiner and the Examiner's supervisor about this matter.

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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8 October 2004
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